

Application No.: 09/890,784

Docket No.: 21499-00049-US

REMARKS

Reconsideration of claims 1-30 is respectfully requested. The rejection of claims 1-30 under 35 U.S.C. §112, first paragraph as failing to describe in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention, is respectfully traversed.

The Office Action rejects claims 1-30 because in the previous Amendment Applicants amended the transitional claim term "consist of" to either "consisting essentially of" or "comprising". The Office Action argues that because the amended claim terms are broader terms than the previously recited "consists of", the specification does not have written support for the broader terms. The Office Action argues that the claims, which were written in product by process form, exclude or are closed to other ingredients. Applicants disagree, and point specifically to Examples 1-4 on pages 6 and 7. The provided Examples clearly indicate that the Applicants, at the time the application was filed, do convey to one skilled in the art that the claimed dispersion could be prepared by the addition of other components not recited in the claim.

For convenience, the components used to prepare the polymer dispersions embodied in Example 1 is listed below. A similar listing can no doubt be produced for Examples 2-4.

Example 1

1. 61.2 parts starch
2. 10 parts 10% NaOH
3. 12.2 parts cationizing chemical
4. 9.1 parts 5%HCl
5. 10 parts CuSO₄
6. 38.1 parts acrylonitrile
7. 100.3 parts butyl acrylate
8. 62.2 parts styrene
9. 110.6 parts 5% H₂O₂
10. 487 parts water

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As provided above, Example 1 contains 10 listed components that are used to prepare a polymer dispersion of the invention. Component 1 refers to the starch and components 6-8 refers to the monomers used in the monomer mixture. The remaining six components are not recited in the claims, though claims 25 and 27 do recite how the starch is cationized by the addition of a cationizing chemical (component 3). Certainly, one skilled in the art would no doubt look to the Examples, and not the claims, to reproduce the inventive polymer dispersions. Therefore, there should be no question that the Examples provide sufficient written support for the claimed polymer dispersions, as amended with "open" transitional language.

Furthermore, on page 5, lines 14-20 the application further describes that a polymerization initiator can be added to the polymerization mixture to prepare the claimed polymer dispersion. This is another indication that the claims as originally filed were not "closed" to the inclusion of other components. Applicants respectfully request that the Examiner consider the original claim term "consists of" with respect to the teachings of the whole content of the application.

Lastly, though just as important, the Application is the result of a National Stage Application filing from a PCT international application filed in Finnish with the Swedish Patent Office. The PCT application was filed using the term "käsittää", which is an equivalent form of the term "comprising". Unfortunately, the original transitional term in the PCT application was incorrectly translated to the term "consists of". There is no doubt that at the time the Applicants filed the PCT application in Finnish, they had used an open-ended transitional term to claim their invention. Because of Applicants original use of the term "käsittää", to describe their invention, Applicants respectfully request that the Examiner withdraw the rejection.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 21499-00049-US from which the undersigned is authorized to draw.

Dated: December 1, 2003

Respectfully submitted,

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